

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): **Harris (et al.)**
Serial No.: **09/760,271**
Filed: **January 12, 2001**

Attorney Docket: **0013-011P1**
Examiner: **Alvarez, Raquel**
Group Art Unit: **3682**

Title: **System and Method for Pre-Verifying Commercial Transactions**

MS Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Customer No.: **40972**

INFORMATION DISCLOSURE STATEMENT

Pursuant to 37 C.F.R. §1.56, §1.97, and §1.98, Applicant brings the following documents to the Examiner's attention in the above-referenced application. Forms PTO/SB/08a and PTO/SB/08b listing these documents are submitted herewith. Copies of the references are being provided in accordance with 37 C.F.R. § 1.98(a)(2).

Cited References with Explanation of Relevance:

Applicant brings the following references to the Examiner's attention. The relevance of the attached references is that they were cited in cases that might include some common subject matter with the present application.

1. U.S. Patent No. 3,287,839, issued November 29, 1966 to J. Rotwein et al.;
2. U.S. Patent No. 4,593,936, issued June 10, 1986 to Opel;
3. U.S. Patent No. 4,614,861, issued September 30, 1986 to Pavlov et al.;
4. U.S. Patent No. 5,104,149, issued April 14, 1992 to Hoppe;
5. U.S. Patent No. 5,355,411, issued October 11, 1994 to MacDonald;
6. U.S. Patent No. 5,473,144, issued December 5, 1995 to Mathurin, Jr.;
7. U.S. Patent No. 5,530,438, issued June 25, 1996 to Bickham;
8. U.S. Patent No. 5,575,508, issued November 19, 1996 to Diamond;
9. U.S. Patent No. 5,903,830, issued May 11, 1999 to Joao et al.;
10. U.S. Patent No. 5,953,710, issued September 14, 1999 to Fleming;
11. U.S. Patent No. 6,047,270, issued April 4, 2000 to Joao et al.;
12. U.S. Patent No. 6,055,505, issued April 25, 2000 to Elston;

13. U.S. Patent No. 6,233,565 B1, issued May 15, 2001 to Lewis et al.;
14. U.S. Patent No. 7,096,003 B2, issued August 22, 2006 to Joao et al.;
15. U.S. Patent No. 7,264,154 B2, issued September 4, 2007 to Harris;
16. U.S. Patent No. 7,702,578 B2, issued April 20, 2010 to Fung et al.;
17. U.S. Patent App. 2001/0047330 A1, dated November 29, 2001 by Gephart et al.;
18. U.S. Patent App. 2002/143570 A1, dated October 3, 2002 by Tobita,
(Corresponds to JP 2002-298045 A, cite no. 46);
19. U.S. Patent App. 2002/0169720 A1, dated November 14, 2002 by Wilson et al.;
20. U.S. Patent App. 2004/0078325 A1, dated April 22, 2004 by O'Connor;
21. U.S. Patent App. 2004/0133507 A1, dated July 8, 2004 by Barbour;
22. U.S. Patent App. 2004/0148259 A1, dated July 29, 2004 by Reiners et al.;
23. U.S. Patent App. 2005/0029349 A1, dated February 10, 2005 by McGregor et al.;
24. U.S. Patent App. 2005/0242193 A1, dated November 3, 2005 by Smith et al.;
25. U.S. Patent App. 2006/0261152 A1, dated November 23, 2006 by Wong;
26. PCT App. WO 2000/033497 A2, dated June 8, 2000 by Transactionsecure, L.L.C.;
27. PCT App. WO 00/049586 A1, dated August 24, 2000 by Orbis Patents Ltd.;
28. PCT App. WO 2001/061640 A1, dated August 23, 2001 by Ong,
(Corresponds to CN 1418351 A, cite no. 30);
29. PCT App. WO 2003/023560 A2, dated March 20, 2003 by MasterCard Int'l Inc.;
30. CN Patent Doc. CN 1418351 A, dated May 14, 2003 by Ong,
(English abstract included, corresponds to WO 2001/061640 A1, cite no. 28);
31. EP Patent Doc EP 0 745 961 A2, dated December 4, 1996 by AT & T IPM Corp.;
32. EP Patent Doc. EP 1 006 469 A1, dated December 2, 1998 by Koninklijke KPN
N.V.;
33. JP Patent Doc. JP 08-339407 A, dated December 24, 1996 by AT & T IPM Corp.,
(English abstract included);
34. JP Patent Doc. JP 08-339407 A, dated December 24, 1996 by AT & T IPM Corp.,
(Machine Translation);
35. JP Patent Doc. JP 10-105627 A, dated April 24, 1998 by Hitachi Software Eng Co.
Ltd., (English abstract included);
36. JP Patent Doc. JP 10-105627 A, dated April 24, 1998 by Hitachi Software Eng Co.
Ltd., (Machine Translation);
37. JP Patent Doc. JP 11-250193 A, dated September 17, 1999 by OKI Electric IND Co
Ltd., (English abstract included);
38. JP Patent Doc. JP 11-250193 A, dated September 17, 1999 by OKI Electric IND Co
Ltd., (Machine Translation);

39. JP Patent Doc. JP 2000-306161 A, dated November 2, 2000 by Sony Corp., (English abstract included);
40. JP Patent Doc. JP 2000-306161 A, dated November 2, 2000 by Sony Corp., (Machine Translation);
41. JP Patent Doc. JP 2001-283118 A, dated October 12, 2001 by IBM, (English abstract included);
42. JP Patent Doc. JP 2001-283118 A, dated October 12, 2001 by IBM, (Machine Translation);
43. JP Patent Doc. JP 2001-351050 A, dated December 21, 2001 by Shigeru, (English abstract included);
44. JP Patent Doc. JP 2001-351050 A, dated December 21, 2001 by Shigeru, (Machine Translation);
45. JP Patent Doc. JP 2002-298045 A, dated October 11, 2002 by Fujitsu Ltd., (English abstract included, corresponds to U.S. 2002/143570 A1, cite no. 18);
46. JP Patent Doc. JP 2002-298045 A, dated October 11, 2002 by Fujitsu Ltd., (Machine Translation, corresponds to U.S. 2002/143570 A1, cite no. 18);
47. JP Patent Doc. JP 2002-324219 A, dated November 8, 2002 by Seiko Instruments Inc., (English abstract included);
48. JP Patent Doc. JP 2002-324219 A, dated November 8, 2002 by Seiko Instruments Inc., (English Translation);
49. KR Patent Doc. KR 2000-0024216 A, dated January 29, 2000 by You, (Machine Translation);
50. KR Patent Doc. KR 2000-0037355 A, dated April 19, 2000 by Mobilians Com Co, Ltd., (Machine Translation);
51. KR Patent Doc. KR 10-2004-0072447 A, dated August 18, 2004 by Young, (Machine Translation);
52. Boards of Appeal of the European Patent Office / Datasheet for the Decision of December 13, 2006 regarding: Case No. T 1227/05-3.5.01;
53. Introduction of Credit Card that a User Can Set Up a Use Environment, Pack, Jong Min, Naver News, October 30, 2003; and
54. Certificate Manager v3.0 the most Flexible Approach to digital Certificate and Smart Card Production to Date; Increased Interoperability Provides a cost effective and Manageable Solution for High-volume Production; Author(s) Unknown; Presswire, March 14, 2000 (Dialog Reference, file 9 #0019808924).

Cited Patent Applications with Explanation of Relevance:

Applicant also brings the following patent applications and related documents to the Examiner's attention because these patent applications might contain some common subject matter with the above-referenced patent application.

1. U.S. Patent Application Serial No. 09/617,361, filed July 17, 2000, by Harris:

- i. Specification and claims as filed July 17, 2000 (cite no. CC);
- ii. Office Action dated July 7, 2003 (cite no. CD);
- iii. Office Action dated March 25, 2004 (cite no. CE);
- iv. Advisory Action dated July 29, 2004 (cite no. CF);
- v. Office Action dated February 28, 2005 (cite no. CG);
- vi. Office Action dated November 16, 2005 (cite no. CH);
- vii. Office Action dated August 30, 2006 (cite no. CI);
- viii. Restriction Requirement dated May 1, 2007 (cite no. CJ);
- ix. Office Action dated July 6, 2007 (cite no. CK);
- x. Office Action dated March 7, 2008 (cite no. CL);
- xi. Notice of Appeal with Appeal Brief dated September 5, 2008 (cite no. CM);
- xii. Examiner's Answer Brief dated November 25, 2008 (cite no. CN);
- xiii. Office Communication dated January 12, 2009 (cite no. CO);
- xiv. Applicant's Reply Brief dated January 26, 2009 (cite no. CP);
- xv. Office Communication dated April 1, 2009 (cite no. CQ);
- xvi. Office Communication dated May 4, 2009 (cite no. CR);
- xvii. Office Action dated September 3, 2009 (cite no. CS);
- xviii. Examiner's Answer Brief dated October 5, 2009 (cite no. CT);
- xix. Office Communication dated March 5, 2010 (cite no. CU);
- xx. Appeal Decision dated September 14, 2011 (cite no. CV);
- xxi. Request for Rehearing dated November 14, 2011 (cite no. CW);
- xxii. Office Communication dated January 20, 2012 (cite no. CX); and
- xxiii. Notice of Allowance dated April 6, 2012 (cite no. CY).

The present application is a continuation-in-part of U.S. Application No. 09/617,361.

2. PCT Application No. PCT/US2001/022313, filed July 16, 2001, by Harris:

- i. International Publication No. WO 2002/008995 A1 (not cited);
- ii. International Search Report dated October 9, 2001 (cite no. CZ);
- iii. Written Opinion dated July 24, 2003 (cite no. DA); and
- iv. International Preliminary Report on Patentability dated December 15, 2003 (cite no. DB).

This application is an International Phase Application of U.S. Application No. 09/617,361 and the present application. Therefore, a copy of the specification and claims of this application is not being provided because it would be unnecessarily cumulative.

3. AU Application No. 2001273490, filed July 16, 2001, by Harris:

- i. Office Action dated August 10, 2006 (cite no. DC);
- ii. Office Action dated July 19, 2007 (cite no. DD); and
- iii. Office Action dated May 7, 2008 (cite no. DE).

This application is an Australian National Phase Application of PCT Application No. PCT/US2001/022313. Therefore, a copy of the specification and claims of this Australian application is not being provided because it would be unnecessarily cumulative.

4. AU Application No. 2008202099, filed May 9, 2008, by Harris:

- i. Office Action dated December 9, 2008 (cite no. DF); and
- ii. Office Action dated December 10, 2009 (cite no. DG).

This application is a divisional of Australian Application No. 2001273490, which is an Australian National Phase Application of PCT Application No. PCT/US2001/022313. Therefore, a copy of the specification and claims of this Australian application is not being provided because it would be unnecessarily cumulative.

5. CA Application No. 2,415,366, filed July 16, 2001, by Harris:

- i. Office Action dated January 11, 2012 (cite no. DH).

This application is a Canadian National Phase Application of PCT Application No. PCT/US2001/022313. Therefore, a copy of the specification and claims of this Canadian application is not being provided because it would be unnecessarily cumulative.

6. CN Application No. 01812985.4, filed July 16, 2001, by Harris:

- i. Office Action dated May 28, 2004 (English translation; cite no. DI); and
- ii. Notice of Allowance dated January 14, 2005 (English translation; cite no. DJ).

This application is a Chinese National Phase Application of PCT Application No. PCT/US2001/022313. Therefore, a copy of the specification and claims of this Chinese application is not being provided because it would be unnecessarily cumulative.

7. EP Application No. 01 952 770.4-2221, filed December 20, 2002, by Harris:

- i. European Search Report dated June 25, 2007 (cite no. DK);
- ii. Office Action dated September 13, 2007 (cite no. DL); and
- iii. Office Action dated April 17, 2008 (cite no. DM).

This application is a European National Phase Application of PCT Application No. PCT/US2001/022313. Therefore, a copy of the specification and claims of this European application is not being provided because it would be unnecessarily cumulative.

8. JP Application No. 2002-514625, filed January 14, 2003, by Harris:

- i. Office Action dated May 16, 2011 (English translation; cite no. DN); and
- ii. Office Action dated November 16, 2011 (Non-English translation; cite no. DO).

This application is a Japanese National Phase Application of PCT Application No. PCT/US2001/022313. Therefore, a copy of the specification and claims of this Japanese application is not being provided because it would be unnecessarily cumulative.

9. KR Application No. 7017899/2002, filed December 27, 2002, by Harris:

- i. Office Action dated August 24, 2007 (English translation; cite no. DP); and
- ii. Notice of Allowance dated May 30, 2008 (English translation; cite no. DQ).

This application is a Korean National Phase Application of PCT Application No. PCT/US2001/022313. Therefore, a copy of the specification and claims of this Korean application is not being provided because it would be unnecessarily cumulative.

10. NZ Application No. 523746, filed January 23, 2003, by Harris:

- i. Office Action dated January 29, 2004 (cite no. DR); and
- ii. Notice of Allowance dated October 12, 2004 (cite no. DS).

This application is a New Zealand National Phase Application of PCT Application No. PCT/US2001/022313. Therefore, a copy of the specification and claims of this New Zealand application is not being provided because it would be unnecessarily cumulative.

11. U.S. Patent Application Serial No. 10/889,227, filed July 12, 2004, by Harris:

- i. U.S. Patent No. 7,264,154 (cite no. AO);
- ii. Restriction Requirement dated September 19, 2006 (cite no. DT);
- iii. Office Action dated January 19, 2007 (cite no. DU); and
- iv. Notice of Allowance dated June 15, 2007 (cite no. DV).

12. PCT Application No. PCT/US2005/024242, filed July 8, 2005, by Harris:

- i. International Publication No. WO 2006/017165 A2 (not cited);
- ii. International Search Report and Written Opinion dated February 12, 2007 (cite no. DW); and
- iii. International Preliminary Report on Patentability dated April 12, 2007 (cite no. DX).

This application is an International Phase Application of U.S. Application No. 10/889,227, now issued U.S. Patent No. 7,264,154. Therefore, a copy of this International Phase Application is not being provided because it would be unnecessarily cumulative.

13. AU Application No. 2005271884, filed January 12, 2007, by Harris:

- i. Office Action dated April 9, 2010 (cite no. DY); and
- ii. Notice of Allowance dated March 9, 2011 (cite no. DZ).

This application is an Australian National Phase Application of PCT Application No. PCT/US2005/024242. Therefore, a copy of the specification and claims of this Australian application is not being provided because it would be unnecessarily cumulative.

14. CN Application No. 200580030587.X, filed March 12, 2007, by Harris:

- i. Office Action dated February 12, 2010 (English translation; cite no. EA); and
- ii. Office Action dated July 7, 2011 (English translation; cite no. EB).

This application is a Chinese National Phase Application of PCT Application No. PCT/US2005/024242. Therefore, a copy of the specification and claims of this Chinese application is not being provided because it would be unnecessarily cumulative.

15. CN Application No. 201010239623.6, filed July 8, 2005, by Harris:

- i. Office Action dated May 17, 2011 (English translation; cite no. EC); and
- ii. Office Action dated June 1, 2012 (English translation; cite no. ED).

This application is a division of Chinese Application 200580030587.X, which is a Chinese National Phase Application of PCT Application No. PCT/US2005/024242. Therefore, a copy of the specification and claims of this Chinese application is not being provided because it would be unnecessarily cumulative.

16. EP Application No. 05 769 377.2, filed February 9, 2007, by Harris:

- i. European Search Report dated February 16, 2010 (cite no. EE); and
- ii. Office Action dated July 01, 2010 (cite no. EF).

This application is a European National Phase Application of PCT Application No. PCT/US2005/024242. Therefore, a copy of the specification and claims of this European application is not being provided because it would be unnecessarily cumulative.

17. IL Application No. 180640, filed January 10, 2007, by Harris:

- i. Office Action dated January 31, 2010 (English translation; cite no. EG).

This application is an Israeli National Phase Application of PCT Application No. PCT/US2005/024242. Therefore, a copy of the specification and claims of this Israeli application is not being provided because it would be unnecessarily cumulative.

18. IN Application No. 379/DELNP/2007, filed January 15, 2007, by Harris:

- i. Office Action dated March 07, 2011 (English translation; cite no. EH).

This application is an Indian National Phase Application of PCT Application No. PCT/US2005/024242. Therefore, a copy of the specification and claims of this Indian application is not being provided because it would be unnecessarily cumulative.

19. JP Application No. 2007-521513, filed January 10, 2007, by Harris:

- i. Office Action dated July 6, 2011 (English translation; cite no. EI); and
- ii. Office Action dated February 1, 2012 (English translation; cite no. EJ).

This application is a Japanese National Phase Application of PCT Application No. PCT/US2005/024242. Therefore, a copy of the specification and claims of this Japanese application is not being provided because it would be unnecessarily cumulative.

20. KR Application No. 7002939/2007, filed February 6, 2007, by Harris:

- i. Office Action dated October 17, 2011 (English translation; cite no. EK).

This application is a Korean National Phase Application of PCT Application No. PCT/US2005/024242. Therefore, a copy of the specification and claims of this Korean application is not being provided because it would be unnecessarily cumulative.

21. MX Application No. MX/A/2007/000484, filed January 12, 2007, by Harris:

- i. Office Action dated June 3, 2009 (English translation; cite no. EL);
- ii. Office Action dated December 15, 2009 (English translation; cite no. EM); and
- iii. Notice of Allowance dated May 24, 2010 (English translation; cite no. EN).

This application is a Mexican National Phase Application of PCT Application No. PCT/US2005/024242. Therefore, a copy of the specification and claims of this Mexican application is not being provided because it would be unnecessarily cumulative.

22. NZ Application No. 552703, filed January 19, 2007, by Harris:

- i. Office Action dated August 11, 2008 (cite no. EO);
- ii. Office Action dated August 18, 2009 (cite no. EP);
- iii. Office Action dated November 19, 2009 (cite no. EQ); and
- iv. Notice of Allowance dated March 10, 2010 (cite no. ER).

This application is a New Zealand National Phase Application of PCT Application No. PCT/US2005/024242. Therefore, a copy of the specification and claims of this New Zealand application is not being provided because it would be unnecessarily cumulative.

23. U.S. Patent Application Serial No. 11/895,837, filed August 28, 2007, by Harris:

- i. U.S. Patent No. 7,753,265 (not cited);
- ii. Office Action dated June 12, 2008 (cite no. ES);
- iii. Office Action dated March 9, 2009 (cite no. ET);
- iv. Notice of Allowance dated January 11, 2010 (cite no. EU); and
- v. Office Communication dated June 9, 2010 (cite no. EV).

This application is a continuation of U.S. Application No. 10/889,227, now issued U.S. Patent No. 7,264,154. Therefore, a copy of the specification and claims of this U.S. Application is not being provided because it would be unnecessarily cumulative.

24. U.S. Patent Application Serial No. 12/803,219, filed June 22 2010, by Harris et al.:

- i. U.S. Patent No. 8,074,879 (not cited);
- ii. Office Action dated August 31, 2010 (cite no. EW);
- iii. Office Action dated May 9, 2011 (cite no. EX); and
- iv. Notice of Allowance dated August 8, 2011 (cite no. EY).

This application is a continuation of U.S. Application No. 11/895,837, now issued U.S. Patent No. 7,753,265, which is a continuation of U.S. Application No. 10/889,227, now issued U.S. Patent No. 7,264,154. Therefore, a copy of the specification and claims of this U.S. Application is not being provided because it would be unnecessarily cumulative.

25. U.S. Patent Application Serial No. 13/300,142, filed November 18, 2011, by Harris et al.:

- i. Office Action dated April 2, 2012 (cite no. EZ).

This application is a divisional of U.S. Application No. 12/803,219, now issued U.S. Patent No. 8,074,879, which is a continuation of U.S. Application No. 11/895,837, now issued U.S. Patent No. 7,753,265, which is a continuation of U.S. Application No. 10/889,227, now issued U.S. Patent No. 7,264,154. Therefore, a copy of the specification and claims of this U.S. Application is not being provided because it would be unnecessarily cumulative.

Disclosure of Parent Application:

U.S. Patent Application Serial No. 09/617,361, filed July 17, 2000, is the parent application of this application. M.P.E.P. § 609.02(A)(2) provides the following:

The examiner will consider information which has been considered by the Office in a parent application when examining: (A) a continuation application filed under 37 CFR 1.53(b), (B) a divisional application filed under 37 CFR 1.53(b), or (C) a continuation-in-part application filed under 37 CFR 1.53(b). A

listing of the information need not be resubmitted in the continuing application unless the applicant desires the information to be printed on the patent.

Therefore, Applicant presumes that the Examiner is considering the information in the parent application during prosecution of this case in accordance with M.P.E.P. § 609.02(A)(2).

English abstracts are provided to satisfy the requirement for a concise explanation of the relevance of the non-English references, as provided for in M.P.E.P. §609.04(a)(III).

Citation of the above documents shall not be construed as:

1. an admission that the documents are necessarily prior art with respect to the instant invention;
2. a representation that a search has been made, other than as described above; or
3. an admission that the information cited herein is, or is considered to be, material to patentability as defined in 37 C.F.R. §1.56(b).

This information disclosure statement is filed after the mailing of an office action on the merits, but before the mailing of a final action. Therefore, pursuant to 37 CFR §1.97(c), the fee set forth in 37 CFR §1.17(p) is being paid by credit card with the electronic filing of this paper.

Respectfully Submitted,

July 10, 2012
Date: _____

/Gregory P. Gibson/

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CERTIFICATE OF ELECTRONIC FILING

I hereby certify that this paper (along with any referred to as being attached or enclosed) is being filed with the United States Patent and Trademark Office on the date shown below via EFS-Web.

July 10, 2012
Date: _____

/Gregory P. Gibson/

Gregory P. Gibson